

AMENDMENT UNDER 37 C.F.R. § 1.116  
U.S. Appln. No. 09/911,718  
Attorney Docket No.: Q65524

**REMARKS**

Claims 1, 2, 4-13, 15-19, and 21-35 are all the claims pending in the application. By this Amendment, Applicant includes the features of claim 14 into claim 1, thereby canceling claim 14. In addition, claim 18 is amended and the dependency of claims 15-17 are changed to depend on claim 1 as opposed to the canceled claim 14.

***Claims 1, 2, 4-12, 14-17, and 35***

Claims 1, 2, 4-12, 18, 19, 21-29, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over CollegeView.com (<http://web.archive.org/web/19970116182733/http://www.collegeview.com/> (hereinafter “CollegeView”) and U.S. Patent No. 5,659,742 to Beattie et al. (hereinafter “Beattie”) and claims 14-17 and 31-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over CollegeView and Beattie in view of U.S. Patent 5,794,159 to Herr-Hoyman et al. (hereinafter “Herr-Hoyman”). Applicant respectfully traverses these rejections in view of the following comments.

Of these rejected claims, only claim 1 and 18 are independent. Independent claim 1, among a number of unique features, recites: “charging the educational organization according to volume of data at new registration or updating of contents data of an electronic leaflet conducted during the generation of the leaflet.” The Examiner acknowledges that the combined teachings of CollegeView and Beattie do not teach or suggest the charging as set forth in claim 1. The Examiner, however, alleges that Herr-Hoyman cures the deficient teachings of CollegeView and Beattie, and that one of ordinary skill in the art would have been motivated to combine the references to charge a fee from the user (see page 13 of the Office Action). Applicant respectfully disagrees.

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To begin, one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner. CollegeView is a free online college search service, which provides the profiles of thousands of universities and colleges, virtual tours, electronic applications, financial aid information, and career planning tools (*see page 1*). Beattie teaches a method of storing multi-media information in a retrieval system, which has a database for retrieval of the input information in response to a query (*see Abstract*).

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some ***teaching, suggestion or incentive supporting the combination.***” In re Geiger, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)(citing ACS Hosp. Sys. v. Montefiore Hosp. 221 USPQ 929, 933 (Fed. Cir. 1984)). It is improper to “pick and choose” absent some suggestion for the combination. MPEP § 2141.

CollegeView teaches that the user will be provided with information about colleges that match the user criteria. The information about colleges can be viewed by CollegeView online, which provides ten pages of information about the college including link to the colleges’ home page and InfoZap to request written materials from the college of interest via email (pages 4 and 5). That is, the searching necessary for the CollegeView Search Engine is already being performed. There is no motivation or suggestion to replace and/or to somehow attempt to combine the searching engine of CollegeView with the one taught by Beattie.

Finally, the Examiner’s “motivation” rationale contravenes established patent law principles and must be viewed as an impermissible hindsight reconstruction rather than as an effective *prima facie* case of obviousness. Prior art references must be considered as a whole. E.g. In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986). If the Examiner engages in ***picking and***

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*choosing from the references* only so much as supports the rejection and ignores express teachings to the contrary in those references, the Examiner commits *legal error*. Id.

In the present case, the modifications alleged to be motivated by the references contravene express statements to the contrary. CollegeView online is a free online service. That is, CollegeView explicitly discloses not charging for the services. Accordingly, CollegeView reference expressly prefers their services to be free. Herr-Hoyman discloses charging for the services. As a result, Herr-Hoyman, as a whole, teaches away from having free online services. Therefore, one of ordinary skill in the art would not have been motivated to provide the charging of Herr-Hoyman for a free online services. That is, the combined teachings of these references fails to teach or suggest charging the educational organizations. In short, one of ordinary skill in art would not have been motivated to combine CollegeView, Beattie, and Herr-Hoyman in the manner suggested by the Examiner.

Moreover, even if, CollegeView, Beattie, and Herr-Hoyman would be combined in the manner suggested by the Examiner than the users would be charged for the services and not the educational organizations. That is, the combined teachings of these references fails to teach or suggest charging the education organization conducted during electronic leaflet generation.

Therefore, “charging the educational organization according to volume of data at new registration or updating of contents data of an electronic leaflet conducted during the generation of the leaflet,” as set forth in claim 1 is not suggested or taught by the combined teachings of CollegeView, Beattie, and Herr-Hoyman, which lack charging the educational organization during the generation of the leaflet. Moreover, one of ordinary skill in the art would not have been motivated to combine these three different references in the manner suggested by the

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Examiner. For at least these exemplary reasons, claim 1 is patentable over the combined teachings of CollegeView, Beattie, and Herr-Hoyman. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 1 and its dependent claims 2, 4-12, 15-17, and 35. Claim 14 has been canceled. Therefore, this rejection is moot with respect to claim 14.

***Claims 18, 19, 21-29, and 31-34***

As explained with respect to claim 1, one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner. Accordingly, claim 18 is patentable over CollegeView, Beattie, and Herr-Hoyman, at least because these references cannot be validly combined in the manner suggested by the Examiner.

Further, claim 18 recites: “an electronic leaflet generation unit making contents data related to leaflets concerning a plurality of educational organizations into electronic information after the educational organizations register the content data through designation of various kinds of selection items set using icons on a web site or running on a server side.” The combined teachings of CollegeView, Beattie, and Herr-Hoyman do not teach or suggest the educational organizations registering the content data prior to the generation of the leaflets.

That is, CollegeView does not teach or suggest how the information is placed on the website. In other words, in CollegeView, it could be an employee of the online application *i.e.*, CollegeView employee, that gathers the information about a number of colleges and stores them in a database. In CollegeView, there is no teaching or suggestion that the colleges register information about their respective college with the online application.

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Both Beattie and Herr-Hoyman fail to cure the deficient teachings of CollegeView. That is, both Beattie and Herr-Hoyman do not teach or suggest an electronic leaflet generation unit that would place the contents data related to leaflets concerning a plurality of educational organizations into electronic information. That is, neither Beattie, nor Herr-Hoyman disclose making the electronic leaflets concerning plurality of educational organizations. Moreover, both references fail to teach or suggest having the educational organizations register the content data. In Beattie and Herr-Hoyman, there is no teaching or suggestion of the educational organizations registering their content data on the web site. In short, both references fail to teach or suggest generating an electronic leaflet concerning a plurality of educational organizations after the educational organizations register the content data.

Therefore, “an electronic leaflet generation unit making contents data related to leaflets concerning a plurality of educational organizations into electronic information after the educational organizations register the content data through designation of various kinds of selection items set using icons on a web site on running on a server side,” as set forth in claim 18 is not suggested or taught by the combined teachings of CollegeView, Beattie, and Herr-Hoyman, which lack having the educational organizations register the contents data prior to the generation of electronic leaflets. For at least these exemplary reasons, claim 18 is patentable over the combined teachings of CollegeView, Beattie, and Herr-Hoyman. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 18 and its dependent claims 19, 21-29, and 31-34.

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***Claims 13 and 30***

Finally, the Examiner rejected claims 13 and 30 under 35 U.S.C. § 103(a) as being unpatentable over CollegeView and Beattie in view of U.S. Patent 6,347,943 to Fields et al. (hereinafter “Fields”). Claims 13 and 30 depend on claims 1 and 18, respectively. Applicant has already demonstrated that the combined teachings of CollegeView, Beattie, and Herr-Hoyman do not teach or suggest unique features recited in the independent claims 1 and 18. Fields is only cited for its teaching of assessment mechanism. Clearly, Fields does not cure the deficient teachings of CollegeView, Beattie, and Herr-Hoyman. Therefore, claims 13 and 30 are patentable at least by virtue of their dependency on the independent claims 1 and 18, respectively.

Moreover, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner. In particular, the Examiner alleges that one of ordinary skill in the art would have been motivated to combine the references in order to allow the user to select a customized course of instructions based on assessment of each user’s knowledge of a particular topic (*see* pages 11-12 of the Office Action). In addition, the Examiner alleges that information concerning course selection, such as the customized data adds to and improves the information available to a user searching in this area (*see* pages 4-5 of the Office Action). Applicant respectfully disagrees.

As explained above, in order for a claim to be “directed to obvious subject matter, either [1] the references must expressly or impliedly suggest the claimed combination or [2] the examiner must present a convincing line of reasoning [not based on hindsight] as to why the artisan would have found the claimed invention to have been obvious in the light of the teachings of the references.” E.g., Ex parte Clapp, 227 USPQ 972, 973 (P.T.O. Bd. Pat. App. & Interf.

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1985); see also, e.g., Ex parte Levengood, 28 USPQ2d 1300, 1301-02 (P.T.O. Bd. Pat. App. & Interf. 1993).

Establishing that *each element of a claimed combination was known* in the prior art, however, *is not dispositive of patentability*. E.g. Rosemount, Inc. v. Beckman Instruments 221 USPQ 1, 7 (Fed. Cir. 1984). Obviousness under 35 U.S.C. § 103 additionally necessitates a showing that the prior art, including the knowledge available to one of ordinary skill in the art, provided *some suggestion or motivation to combine* the known elements in the manner claimed. See, e.g., Fromson v. Advance Offset Plate 225 USPQ 26, 31 (Fed. Cir. 1985).

A person of ordinary skill in the art would not have pulled all the disparate elements of the prior art together to create the subject matter defined by claims 13 and 30. Nothing in the prior art suggests the desirability and thus the obviousness of combining these disparate elements. CollegeView only relates to selecting colleges (page 1, 2, and 4) and Beattie only relates to storing and retrieving multi-media information. Fields provides a system for creating individualized courses based on the assessment (see *Abstract*). The created individualized courses would not help the user to select a college. Indeed, the creation of the customized courses would not improve the process of searching for and selecting a college, as alleged by the Examiner. In short, a person of ordinary skill in the art would not have pulled these disparate elements of the prior art together in the manner suggested by the Examiner. Accordingly, Applicant respectfully submits that one of ordinary skill in the art concerned with college searches would not have been motivated to provide a user with customized course of instructions, as suggested by the Examiner.

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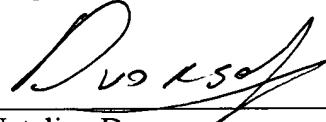
For at least this additional reason, Applicant respectfully submits that dependent claims 13 and 30 are patentable over the combined teachings of CollegeView, Beattie, and Fields.

***Conclusion***

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Nataliya Dvorson  
Registration No. 56,616

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

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